

AUG 31 2006

PTO/58/21 (07-08)

Approved for use through 08/30/2008. OMB 0851-0031


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TRANSMITTAL FORM	Application Number	10616,133
	Filing Date	07/08/2003
	First Named Inventor	O'NEILL, Mary Morabito
	Art Unit	3641
	Examiner Name	CHAMBERS, Troy
(to be used for all correspondence after initial filing)		
Total Number of Pages in This Submission	8	Attorney Docket Number 02W234

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Duplicate Fee transmittal form
Remarks _____ Title: Obscuration Method for Reducing the Infrared Signature of an Object		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Raytheon Company		
Signature			
Printed name	William C. Schubert		
Date	31 August 2006	Reg. No.	30,102

CERTIFICATE OF TRANSMISSION/MAILING FAX No. 571-273-8300

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	William C. Schubert	Date	31 August 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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AUG 31 2006

PTO/SB/17 (07-08)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL **For FY 2005**

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

Complete if Known

Application Number 10/615,133
Filing Date 07/08/2003
First Named Inventor O'NEILL, Mary Morabito
Examiner Name CHAMBERS, Troy
Art Unit 3641
Attorney Docket No. 02W234

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 50-0616 Deposit Account Name: Raytheon Company

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Fee (\$) 50
Small Entity Fee (\$) 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

Multiple Dependent Claims

- 20 or HP = x =

Fee (\$) **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 3 or HP = x =

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**

- 100 = / 50 = (round up to a whole number) x =

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Fee Paid (\$)

Other (e.g., late filing surcharge): Petition (\$130)

n/a

130

SUBMITTED BY

Signature *William C. Schubert* Registration No. 30,102 Telephone 805/562-2108
Name (Print/Type) William C. Schubert Date 31 August 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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AUG 31 2006

PD-02W234

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
MARY MORABITO O'NEILL et al.)	GAU: 3641
Ser. No. 10/615,133)	Examiner:
Filed: July 8, 2003)	T. Chambers
For: OBSCURATION METHOD FOR REDUCING THE)	
INFRARED SIGNATURE OF AN OBJECT)	

PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Advisory Action mailed March 28, 2006 included as an attachment a new Final Rejection, in which claims 13 and 21 were rejected over prior art for the first time. The rules have no provision for a new rejection being provided as an attachment to an Advisory Action. The rules have no provision that a new rejection of previously pending, unamended claims may be made final. Applicant petitions to have this action of the examiner nullified, so that the case proceeds either without claims 13 and 21 being rejected, or a new nonfinal Office Action is issued.

The pertinent history of the application is as follows.

Claims 1-22 were in the application as filed. In the first Office Action of January 11, 2005, claims 13 and 21 were rejected under 35 USC 112, but not under any prior art grounds.

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The Office Action of June 28, 2005 withdrew the rejection of claims 13 and 21 under 35 USC 112, and did not include any other rejection of either claim 13 or claim 21. The responsive Amendment prominently included the following paragraph immediately following the introductory paragraph of the Remarks:

"Applicant calls to the Examiner's attention that claims 13 and 21 are not included in a statement of any rejection, even though para. 6 of the Office Action Summary indicates that they are rejected."

The Final Office Action of January 31, 2006 did not contain a rejection of either claim 13 or claim 21. The Response to Final Office Action prominently included the following statement immediately following the introductory paragraph:

"1. There is stated no prior art rejection of claims 13 and 21, and no rejection at all of claim 21. Although these claims are mentioned in the explanation of the rejection of para. 17, 24, and 30, they are not included in the statement of the rejection set forth in para. 9, as is required by MPEP 707.07 and particularly MPEP 707.07(d), most particularly the second sentence of MPEP 707.07(d). Para. 30 references para. 15 and para. 22 of the previous Office action, but as pointed out in the second paragraph under Remarks of the Amendment filed in response to the Office Action of June 28, 2005, claims 13 and 21 were not included in a statement of a rejection in that Office Action either. Applicant is only asking that the clear instructions on formatting statements of rejections be followed. Applicant's past experience has been that when this type of mistake is pointed out it is corrected in the next office action, and does not understand why that has not been done here. Unless the statement of the rejection is modified, the finality of the rejection is withdrawn, and a new nonfinal rejection of these claims is made, on appeal Applicant will be forced to treat these claims as not

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rejected on any grounds of prior art because they are not addressed in the first sentence of any of the prior art rejections."

The Response to Advisory Action of March 28, 2006 stated in part:

"The attachment to the Advisory Action, an attempt to issue a new final rejection of previously unrejected claims, as an attachment to an Advisory Action, is improper for three reasons.

First, the rules do not provide for issuing an office action that newly rejects previously pending claims as an attachment to an advisory action.

Second, claims 13 and 21 were not previously rejected. The attachment thus attempts to make final the first rejection of claims that were not previously rejected.

Third, the argument of paragraph 31 of the attachment is not correct. No claim was amended in the prior Response to the Office Action of January 31, 2006, which would justify making a new office action final."

Up until the recent (second) Advisory Action, there had been no response to Applicant's notification of the absence of a rejection of claims 13 and 21. Applicant understands that errors sometimes happen and a claim is inadvertently not addressed. Normally, when the error is pointed out, it is immediately rectified, and the case moves on. In this instance, the error was not corrected, even after it was pointed out.

The recent (second) Advisory Action seeks to justify the issuance of the new final rejection of claims 13 and 21 in the attachment to the Advisory Action of March 28, 2006. The recent (second) Advisory Action first argues that "while those claims were not mentioned in the first sentence of the rejection they were noted as being rejected in the body of the Office action." This argument is not persuasive, because it leaves the Applicant guessing as to whether the claim is actually rejected under that

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ground, and is contrary to the rules. MPEP 707.07(d), Language To Be Used in Rejecting Claims, provides

"Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated, and the word 'reject' must be used. The examiner should designate the statutory basis for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection."

In general, it is not uncommon practice to mention a claim in the explanation of a rejection which does not reject the claim, for example by way of cross reference to the rejection of that claim under another ground. The practice of MPEP 707.07(d) eliminates ambiguity as to which claims are actually to be rejected under a ground. Further, on appeal, the Applicant is constrained to address only the claims that are properly rejected in the format of MPEP 707.07(d). If claims are not rejected in the opening sentence of a ground of rejection, Applicant has no basis for appeal.

The (second) Advisory Action then seeks to characterize the failure to properly reject claims 13 and 21 as "mere typographical error". That was certainly a possibility the first time there was no rejection of claims 13 and 21, but not after Applicant had straightforwardly informed the examiner of the omission.

The (second) Advisory Action then states: "If the applicant believes claims 13 and 21 to include allowable subject matter and intends to amend independent claims to include said subject matter, then the applicant is free to do so." Applicant responds, first, that the ability to amend the claims to independent form after final rejection does not provide the same range of possible actions as does a nonfinal rejection. Second, Applicant declines to participate in a violation of the rules, which have no provision for an Office Action that newly rejects claims to be issued as an attachment to an Office Action, and do not permit claims 13 and 21 to be finally rejected in the present circumstances.

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Applicant therefore requests that the rules be followed, and that either (1) a new nonfinal Office Action be issued that rejects claims 13 and 21, or (2) a clear statement be made that claims 13 and 21 are not rejected so that Applicant will not have to address those claims in the Appeal Brief.

Respectfully submitted,



William Schubert

Reg. No. 30,102

Attorney for Applicant